

REMARKS

In the Office Action, the Examiner noted that claims 1-20 are pending in the application; that claims 1-20 are rejected. By this argumentative response and request for reconsideration, claims 1-20 remain pending in this application.

Rejections Under 35 U.S.C. §103

Claims 1-6, 10-18, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen, et al.* (U.S. Patent No. 6,065,120), hereinafter *Laursen*, in view of HP Jetsend Technology Making Device-To-Device Communication Simple (hereinafter *Jetsend*):
<http://web.archive.org/web/19980124223300/www.jetsend.com/Backgrnder.html>
 (p.1-6, 1/24/98) further in view of *Wright Jr.* (U.S. Patent No. 5,704,029, 12/30/97), hereinafter *Wright*.

Claim 9 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen*, in view of *Jetsend*, further in view of *Wright* (U.S. Patent No. 5,704,829), and further in view of *Paltenghe, et al.* (U.S. Patent No. 6,421,729 B1). Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen*, in view of *Jetsend*, further in view of *Wright* (U.S. Patent No. 5,704,829), and further in view of *Covert, et al.*, hereinafter *Covert* (U.S. Patent No. 6,334,517 B1). Claims 8 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen*, in view of *Jetsend*, further in view of *Wright*, and further in view of *Covert*, as applied to claim 7, and further in view of *Laor* (U.S. Patent No. 6,041,309).

With regard to claim 1, the Examiner has taken the position that *Laursen* discloses the accessing, displaying (rendering) of HTML forms located on the Internet server, via an HTML microbrowser.

With regard to claim 1, the Examiner has taken the position that *Jetsend* teaches using a computer or device for sending documents, pictures, etc. to a printer over the Internet with a jetsend-surface-interaction protocol capable printer.

With regard to independent claim 1, the Examiner has taken the position that *Wright* teaches the transferring, displaying (rendering) of a form(s),

in multiple versions or format, to a PDA from a computer, where the creation of the form takes place at the computer.

First, the Examiner asserts with regard to claim 1 that it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of *Laursen* and Jetsend because Jetsend teaches the intelligent negotiation of information, from devices, without user intervention, thus enabling seamless transmission across computer networks.

Next, the Examiner asserts with regard to claim 1 that it would have been obvious to one of ordinary skill in the art at the time to combine the teachings of *Laursen* and Wright because *Laursen* teaches the display of web pages in small-sized mobile devices, and that a PDA is both mobile and small in size, and Wright teaches a form displaying method for conveniently displaying multiple document versions one question or statement at a time on a PDA.

Applicant respectfully disagrees with the Examiner and hereby traverses the rejections.

To establish a *prima facie* case of obviousness, the Examiner must provide: 1) one or more references, 2) that were available to the inventor and, 3) that teach, 4) a suggestion to combine or modify the reference(s), 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Applicant traverses the rejection to claim 1. The Examiner has not made this showing, and a *prima facie* case of obviousness has not been demonstrated. More particularly, the fourth element, above, is not present because there lacks a reason, suggestion, or motivation from the prior art as a whole for the person of ordinary skill to have combined or modified the references because Wright teaches away from the claimed combination.

It is understood that, when the prior art teaches away from the claimed combination, it is a factor cutting against a finding of motivation to combine or modify the prior art. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that the applicant took (*In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir 1994).

Wright teaches a system and method that uses a PDA along with a personal computer (PC) having a forms creation program that facilitates the creation, completion, and validation of the forms in a completely electronic manner so that paper forms do NOT have to be printed and stored (see col. 6, ll. 24-29). *Wright* teaches a system and method that "eliminates paper forms from a previously intensive paper process" (see col. 28, ll. 54-55). The system and method also "significantly reduces form creation and modification cost by eliminating layout necessary for paper forms" (see col. 28, ll. 60-61).

In contrast, the present invention of claim 1 is directed to an output device including a printer with a control interface and an information exchange protocol for receiving forms transmitted from a web server and rendering user-perceptible forms. When a printer renders a form, the form is a hard copy form, such as paper or transparency material. *Wright* teaches away from rendering user-perceptible forms from a printer because *Wright* suggests that the line of development flowing from *Wright's* disclosure (the complete elimination of paper forms) is unlikely to be productive of the result being sought by the present invention of claim 1 (the easy generation of forms from a printer using a request initiating client machine including a personal digital assistant).

Applicant's invention does not propose the elimination of paper forms. Quite the opposite, Applicant's invention is directed to a providing the capabilities of a forms printing solution to machines having very limited capabilities such as personal digital assistants (PDAs). See p. 4, ll. 3-8 of the pending application.

The same argument applies to independent claims 11 and 18. Independent claim 11 includes an output device for rendering forms, while independent claim 18 includes the step of "printing the rendered form at the output device". The application of *Wright* in combination with *Laursen* and *Jetsend* fails with these independent claims for the same reason as recited above with reference to independent claim 1. Likewise, remaining claims 2-10, 12-17, and 19-20 are dependent on independent claims 1, 11, and 18, respectively, and the rejection of these dependent claims is also in error and they are also non-obvious.

For at least these reasons, the rejection of claims 1-20 under 35 U.S.C. §103(a) is clearly in error and should be withdrawn, and claims 1-20 should be allowed.

Additionally, claims 8 and 19 stand rejected by the Examiner as being obvious and unpatentable over *Laursen*, in view of *Jetsend*, further in view of *Wright*, further in view of *Covert*, and further in view of *Laor*. Such an application of references is an attempt to piecemeal reconstruct the claimed invention using hindsight analysis.

To prevent the use of hindsight analysis based on the invention to defeat patentability of the invention, the Examiner is required to show a motivation to combine the references that create a case of obviousness. In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Examiner has not made this showing with regard to any of the dependent claims 2-10, 12-17, and 19-20. The suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. (See *In re Rouffet*, 47 USPQ 2d 1453, 1457-58 (Fed. Cir. 1998).)

The relevant inquiry is whether there is a reason, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. Such a suggestion or motivation may come from the references themselves, from knowledge by those skilled in the art that certain references are of special interest in a field, or even from the nature of the problem to be solved. (See *Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 51 USPQ 2d 1415, 1420-21 (Fed. Cir. 1999).)

In the present case, a suggestion or motivation is lacking in the art.

In the present case, the Examiner has impermissibly applied hindsight analysis when analyzing the patentability of claims 1-20 pursuant to §103. The Examiner is required to cast the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art guided only

by the prior art references and the then accepted wisdom in the field. (See *In re Dembiczak*, 50 USPQ 2d 1614, 1616-17 (Fed. Cir. 1999) (quotations omitted).

Accordingly, the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. (See *Dembiczak*, 175 F.3d at 999, 50 USPQ 2d at 1617.) Here, the Examiner has pieced together the prior art to defeat patentability of the present invention by combining prior art references without evidence of such a suggestion, teaching, or motivation. This provides the essence of hindsight. Although the suggestion to combine references may flow from the nature of the problem, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ 2d 1626, 1630 (Fed. Cir. 1996), "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness," *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ 2d 1977, 1981 (Fed. Cir. 1998). Here, the Examiner has exercised improper hindsight analysis in an attempt to create a system that provides for the easy generation of forms from a printer using a request-initiating client machine including a personal digital assistant. However, there is no teaching or suggestion to make each of the cited combinations. Additionally, *Wright* teaches away from this system.

Accordingly, claims 1-20 are believed to be non-obvious and patentable in light of the cited prior art of record. Withdrawal of these rejections is respectfully requested.

CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be

anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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